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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,266	01/21/2004	Kia Silverbrook	WAL12US	1038
24011	7590	10/10/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			NGUYEN, LAM S	
			ART UNIT	PAPER NUMBER
			2853	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/760,266

Applicant(s)

SILVERBROOK ET AL.

Examiner

LAM S. NGUYEN

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.  
4a) Of the above claim(s) 2,6,8-12,14-30,32-36 and 42-48 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3-5,7,13,31,37-41 and 49 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/12/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

In response to the restriction requirement, the applicant elected claims 1, 3-5, 7, 13, 31, 37-41, and 49 for further examination. As a result, claims 2, 6, 8-12, 14-30, 32-36, and 42-48 are withdrawn from consideration.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 38 of U.S. Patent No. 6944970. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 38 of U.S. Patent No. 6944970 anticipates the claim in the present application.
2. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 39 of U.S. Patent No. 6920704. Although the conflicting claims

are not identical, they are not patentably distinct from each other because claim 39 of U.S. Patent No. 6920704 anticipates the claim in the present application.

3. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over each of claim 40 of copending Application No. 10/760257, claim 39 of copending Application No. 10/760288, claim 39 of copending Application No. 10/760225, claim 41 of copending Application No. 10/760251, claim 41 of copending Application No. 10/760256, claim 40 of copending Application No. 10/760240, claim 41 of copending Application No. 10/760226, claim 40 of copending Application No. 10/760224, claim 42 of copending Application No. 10/760199, claim 41 of copending Application No. 10/7602193, claim 42 of copending Application No. 10/760269, claim 42 of copending Application No. 10/760260, claim 41 of copending Application No. 10/760241, claim 41 of copending Application No. 10/760230, claim 41 of copending Application No. 10/760215, or claim 42 of copending Application No. 10/760214. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the identified claims above anticipates the current claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-4, 7, 13, 31, 37-38, 41, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Nozawa (US 5701147).

**Regarding to claims 1, 31, 37-38, 41, 49:**

Martin discloses a method/apparatus for printing wallpaper onto a web of media (*FIG. 2, element 27*), comprising the steps of:

utilizing an on-demand printer comprising a cabinet/frame (*FIG. 2, element 18*) in which is located a media path which extends from a media loading area (*FIG. 2, element 24*) to a winding area/dispensing slot (*FIG. 2, element 26*), there being a printhead (*FIG. 2, element 20*) located across the media path, there being a processor (*FIG. 2, element 38*) which accepts operator inputs from one or more input devices (*FIG. 2, element 32*) and which controls the printer;

using one or more input devices which communicate with the processor to capture data from an operator regarding a specification; running the printer according to the data; printing a single roll of wallpaper, on demand, according to a selected pattern and configuration (*paragraphs [0009]-[0010]*);

changing the pattern according to a new datum from an operator; and then printing a new roll onto the same web (*FIG. 1-2: The apparatus is capable to print different patterns inputted by an operator on the same web*).

Martin, however, is silent wherein the printhead is full width.

Nozawa discloses a printing apparatus comprising full width printheads (*FIG. 9, element 204*) for forming images across a moving printing medium (*FIG. 9, element 203*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Martin's printhead to be full width printhead as disclosed by Nozawa.

The motivation for doing so would have been to be able to print the entire width of the printing medium without scanning the printhead to gain printing speed as taught by Nozawa (*column 1, lines 30-39; column 3, lines 57-62*).

- **Martin also discloses the following claimed invention:**

**Regarding to claim 3:** storing to a storage device accessible to the processor and internal to the cabinet, a plurality of selectable files for describing the patterns for printing onto the media (*FIG. 1-2, element 30*).

**Regarding to claims 4, 7:** providing the printer with a video display for depicting the selected pattern or display information relating to a roll (*FIG. 2, element 34*).

**Regarding to claim 13:** the specification for an operator's requirements comprises a pattern and the configuration; the configuration being one or more parameters selected from the group comprising: roll length, a roll slitting arrangement, one or more modifications to the pattern, or a selection of media to be printed on (*paragraph [0010]*).

**Regarding to claims 31, 37, 41:** the winding area adapted to removably retain a core and wind into it, wallpaper produced by the printer (*FIG. 2, element 26*), wherein the length and design of the roll are determined by the operator inputs (*paragraph 0010*).

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Nozawa (US 5701147) applied to claim 1, and further in view of Stoffel et al. (US 6412990).

Martin, as modified, discloses the claimed invention as discussed above except using the video display as a touchscreen input device to capture operator preferences.

Stoffel et al. discloses an printing apparatus having a video display as a touchscreen (*FIG. 15, element 42*) input device to capture operator/customer preferences to allow the operator/customer to custom printing images by simply touching the viewing screen (*column 8, lines 55-60*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Marin's video display (as modified) as a touchscreen as disclosed by Stoffel et al.

The motivation for doing so would have been to allow an operator/customer to custom printing images by simply touching the viewing screen as taught by Stoffel et al. (*column 8, lines 55-60*).

6. Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Nozawa (US 5701147) applied to claim 1, and further in view of Goldstein (US 2002/0069078 A1).

Martin, as modified, discloses the claimed invention as discussed above but is silent about charging a customer for the roll or obtaining/attempting to obtain a fee from a franchisee.

Goldstein discloses a system for creating custom wallpaper including a program to charge and obtain fee from customers ordered printed wallpaper rolls (*FIG. 2, steps 208, 210, 212, 214*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Marin's apparatus (as modified) to include means for charging and obtaining fee from a customer as disclosed by Goldstein et al.

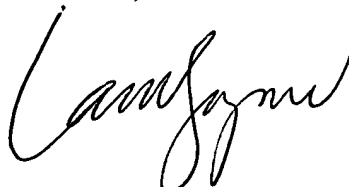
The motivation for doing so would have been to allow an operator/customer to purchase created custom wallpaper as taught by Goldstein (*paragraphs [0043]-[0046]*).

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAM S. NGUYEN whose telephone number is (571)272-2151. The examiner can normally be reached on 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, STEPHEN D. MEIER can be reached on (571)272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LAM SON NGUYEN